

REMARKS/ARGUMENTS

In response to the Office Action dated December 12, 2007, the Examiner is respectfully requested to reconsider this application in light of the following remarks.

As the Examiner will recall, this application was filed to provoke an interference with United States Patent No. 6,290,865 which issued September 18, 2001 and is assigned to Applied Materials, Inc. In the course of prosecuting this application and determining the dates on which the invention was made, applicants discovered that an inventor had been omitted, namely, Mr. Peace. Applicants believe that they have successfully demonstrated that Mr. Peace had been inadvertently omitted as an inventor of the subject application.

As the Examiner observed, applicants submitted the declaration of Mr. Peace to demonstrate conception and reduction to practice of the invention prior to November 30, 1998, the earliest effective filing date available to the '865 patent with which applicants seek to have an interference declared. The Examiner pointed out that a declaration under 37 C.F.R. § 1.131 was not proper and that the appropriate way to proceed would be under the provisions of 37 C.F.R. § 41.202 dealing with suggesting an interference. And, of course, the Examiner's reliance on that rule is absolutely correct. Under § 41.202(d)(1), applicants have a duty to show why they would prevail on priority in the event that an interference is declared.

Applicants believe that the declaration submitted by Mr. Peace does indeed accomplish that result. While it is styled as a declaration under 37 C.F.R. §

1.131, the substance of the declaration establishes that Mr. Peace conceived and reduced to practice, prior to the earliest filing date of the Applied Materials' '865 patent, a specific embodiment falling within the claims common to both applications. Applicants would suggest to the Examiner that it would be a pointless exercise to resubmit the Peace declaration merely to eliminate any reference to 37 C.F.R. 1.131. The Peace declaration should be considered for what it shows in a substantive sense, not the label contained in its title.

The Examiner criticizes the Peace declaration on the ground that the evidence submitted in support of Mr. Peace's allegations are not commensurate in scope with the claims on several grounds. The first is that the evidence does not explicitly demonstrate that the wafer is rotated while undergoing treatment with a rinse fluid and a dissolving fluid. The drawing at the top of the sketch annexed to the declaration is, as the Examiner surely appreciates, a drawing showing the centerline in the left-hand margin. That, of course, reflects the fact that the apparatus in which the wafer is secured is symmetrical on the opposite side of the centerline. The drawing also shows arrows causing fluids to be expelled radially away from the centerline, obviously demonstrating that it is centrifugal force which causes the fluids to flow out radially. And, of course, that centrifugal force, as anyone skilled in the art knows, is a result of rotation of the invention. Indeed, that aspect of the apparatus is well established in the art.

In sum, the sketch obviously shows that rotation of the wafer causes fluids to be expelled radially by reason of centrifugal force.

The Examiner also comments that the evidence submitted with the

declaration does not refer to "the difference in the flow rate between the first and second fluids". The Examiner apparently overlooks the fact that claim 67, corresponding to claim 1 of the Applied Materials' '865 patent, does not require any difference in flow rates. Thus, that criticism cannot be applied with respect to claim 67. While it is, of course, true that independent claim 68 refers to a difference in flow rates, it is obvious from the sketch and the use of liquid and gaseous fluids that a difference in flow rates is inherent. The same is true for a number of other features which the Examiner refers to in paragraph 4(b) of the Office Action. None of those criticisms can be applied to claim 67.

That of course shows that applicants have indeed demonstrated the appropriateness of an interference at least with respect to claim 67 of the present application.

The Examiner's last point in connection with the Peace declaration is a criticism that it is not signed by all of the inventors. An examination of the prosecution history of this application shows that a number of inventors have left the employ of the assignee of the present application and have refused to sign papers in connection with the prosecution, including the declaration and power of attorney. And it would be, on the face of this record, a hardship to require that all inventors sign the declaration.

Perhaps more importantly, however, 37 C.F.R. § 41.202 does not require any showing be executed by all named inventors. The Peace declaration shows beyond any reasonable doubt that an embodiment falling within the scope of at least the broad claims of the Applied Materials' '865 patent and the claims of the

present application was reduced to practice prior to the earliest date of the '865 patent. That showing of a prior reduction to practice of an embodiment within the '865 patent claims prior to the earliest date available to the '865 patent conclusively shows why applicants here would prevail on the issue of priority. In other words, in examining the priority question in light of 37 C.F.R. § 41.202, Mr. Peace's declaration shows, that applicants have established priority. That is an additional – and compelling – reason why the declaration need not be signed by all of the inventors.

The Examiner is therefore respectfully requested to reconsider this application in light of the Peace declaration and find that it is sufficient to establish priority with respect to the present application, at least for the broad claims of the present application, such as claim 67.

In the outstanding office action, the Examiner also rejected a number of the claims on the ground that they do not comply with the written description requirement of § 112. Notable, however, is the fact that claim 67, the broadest claim of this application – which is the same as claim 1 of the '865 patent – is necessarily allowable. That demands that an interference be declared at least with respect to that claim. Applicants would suggest that the written description issues be dealt with in an inter partes context.


In all events, the present specification makes it clear that the first surface which is protected by the "rinse fluid" is necessarily a higher flow rate. That is inherent in the practice of the invention as would be understood by one skilled in the art. Respecting the limitation of "independent mechanical scrubbing"

Application No. 10/647,914  
Reply To Office Action  
Dated December 12, 2007  
Page 12

the same is true. One skilled in the art would recognize from the present disclosure that mechanical scrubbing is not used. Thus, reconsideration of the rejection based on § 112 is respectfully requested.

Finally, the Examiner has maintained the rejection on the '865 patent to Lloyd. As has been pointed out, the Peace declaration shows that, if the Patent Office were to declare an interference between the present application and the '865 patent to Lloyd, priority in favor of this application is demonstrated beyond any real question under 37 C.F.R. § 41.202. The Examiner is therefore respectfully requested to reconsider this application and recommend that an interference be declared.

Respectfully submitted,



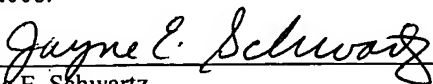
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I hereby certify that this correspondence and/or fee is, on the date shown below, being deposited with the United States Postal Services as Express Mail Post Office to Addressee, EM 154878562 US with sufficient postage, June 12, 2008.

  
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